

Greco et al. U.S. Patent 5,568,540 in view of Brunson et al. U.S. Patent 56,038,296". Applicants respectfully traverse this rejection.

Claims 1, 34, 56 and 73 are the only independent claims. Since these claims are believed novel over the cited art then the claims dependent therefrom are also novel. Accordingly, the following discussion will refer to independent claims 1, 34, 56 and 73.

According to the Examiner on page 3 of the Office Action dated February 28, 2002, Greco et al. disclose every feature of these independent claims except "including a graphical image in the information signal." But now the Examiner contends that Greco et al. fail "to teach that the REPLY button relates the stored message to at least one graphical image associated with the source". More fundamental, however, Greco et al. fails to teach BOTH concepts, not just the latter. The Examiner asserts that

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Greco's method with the teaching of Brunson, so that a source's return address would have been included in the message list, and when a subscriber highlighted a message in a message list and clicked on the REPLY button, the subscriber would have been automatically linked to the sender's home page, and the sender's graphical image would have appeared on the subscriber's computer screen. Because such a modification would have enabled a subscriber to learn more about the sender (or source) of a message in case the sender's name was unfamiliar to the recipient.

Applicants respectfully point out various errors with these assertions.

Improper to Combine References Since No teaching or Suggestion to Combine:

For an Examiner to assert that an invention is obvious over a combination of references, "the examiner must show reasons that the skilled artisan, confronted with the same problems as

the inventor, and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." *In re Rouffet* 149 F.3d 1350 (Fed. Cir. 1998).

The Examiner's reason for the combination of the references is that it would have been obvious to one skilled in the art to combine these references "because such a modification would have enabled a subscriber to learn more about the sender (or source) of a message in case the sender's name was unfamiliar to the recipient."

MPEP 2143.01 provides:

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The Examiner's position that "such a modification would have enabled a subscriber to learn more about the sender (or source) of a message in case the sender's name was unfamiliar to the recipient" fails to comply with the mandate in MPEP 2143.01 that to justify the modification there must be "some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art". As such, the rejection warrants withdrawal on this basis alone since contending

what the "modification would have enabled" is inappropriate rationale to justify making the modification according to MPEP 2143.01, which provides:

**FACT THAT REFERENCES CAN BE COMBINED OR MODIFIED  
IS NOT SUFFICIENT TO ESTABLISH *PRIMA FACIE*  
OBVIOUSNESS**

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)

By relying on a theory that "such a modification would have enabled", the Examiner is merely trying to show the two references can be combined or modified to enable some result, but without showing *suggestion in the prior art* for the desirability of the combination. As such, the Examiner's approach runs afoul of this mandate under MPEP 2143.01.

It follows that the only source of suggestion or incentive for the hypothetical combination of Greco et al. would be from hindsight derived from applicants' invention, which can not be relied upon as a source of a suggestion or motivation. That is, using the claimed invention as a blueprint to pick and choose features from the prior art is inappropriate. Therefore, the combination of Greco et al. with Brunson et al. asserted by the Examiner is non-obvious.

Indeed, a person skilled in the art, when confronted with the same problems as the inventor and with no knowledge of the claimed invention, would have no motivation to combine the teachings of a patent that describes a Method and Apparatus for Selecting and Playing a Voice Mail Message (Greco et al.) with a patent that describes an Internet/Intranet User Interface to a multimedia messaging system (Brunson et al.). Greco et al. is for "telephone switching systems with voice mail features" (col. 1 lines 6-7) whether "deployed with a private branch exchange (PBX) switch or with a central office telephone switching system" (col. 1 lines 20-22). Brunson et al. is for "electronic messaging" (col. 1 line 5) that "comprises a user terminal and a

messaging system interconnected by an Internet/intranet" (col. 2 lines 20-22). As such, there is neither motivation nor incentive to consider making a combination.

Furthermore, the pending independent claims 1, 34, 56 and 73, however, call for both generating an information signal and then transmitting the information signal to a communications device associated with an addressee of the stored message. The information signal relates the stored message to at least one graphical image associated with the source.

While Brunson et al.'s subject matter may reveal sending the recipient's home page to a sender (of a message), this fails to constitute transmitting an information signal to a communications device associated with an addressee of the stored message as recited by the independent claims. Instead, the home page of Brunson is sent to the communications device of the sender, not that of an addressee of the stored message. The home page is never related with a stored message as part of an information signal to be transmitted to an addressee of a stored message. As such, the hypothetical combination fails to read on the claim language.

Since there is no motivation or incentive to combine these references in the manner envisioned by the Examiner, and since neither reference alone or in combination would render these independent claims 1, 34, 56 and 73 obvious, the independent claims are novel over the cited art and should be allowed. Accordingly, Applicants respectfully request the rejection of all claims be withdrawn and the claims be allowed to issue.

The remaining rejected claims are all dependent claims and as such are novel for at least the same reasons discussed above. Accordingly, applicants respectfully request that these rejections be withdrawn as well and the dependent claims also be allowed to issue. Further, each of the dependent claims recite subject matter that would not be obvious to a skilled artisan to obtain merely by combining Greco et al. and Brunson et al. for the purpose of enabling "a

subscriber to learn more about the sender (or source) of a message in case the sender's name was unfamiliar to the recipient" as the Examiner contends. Such forms an insufficient rationale for picking and choosing features from the prior art in an effort to show that the subject matter of the dependent claims is somehow obvious.

Claims 1, 2, 34, 44-46, 56 and 57 were rejected under 35 U.S.C. 103(a) as being unpatentable over Bobo II (US Patent 5,675,507) in view of Witek et al. (US Patent 5,461,488). This rejection is traversed.

The Examiner points to col. 9 lines 2-4 of Bobo II that permits a user to view a list of messages with a reduced size image of the cover page next to each entry on the list, but concedes that Bobo II "fails to teach that the graphical image (cover page) is associated with the source". To make up for this deficiency, the Examiner points to col. 3 lines 3-16 of Witek that reveals that a cover page to be faxed may have on it a company logo (which one might infer to be that of the source of the fax message).

The argument is specious.

According to claim 1, a method of indicating a source of a stored message is recited to include two steps. The first is generating an information signal relating the stored message to at least one graphical image associated with said source. The second is transmitting the information signal to a communications device associated with an addressee of the stored message.

The hypothetical combination of Bobo II and Witek would merely be generating a list and, next to each entry in the list, displaying a reduced image of a cover page that may happen to contain a company logo in it. Therefore, the content of the cover page itself is being relied upon to convey an indication of the company that employs the author of the cover page through

depiction of the company logo in graphic form. This is nothing more than associating the contents of the message itself with the message. Once this is complete, no further transmission occurs. The pending independent claims, however, call for both generating the information signal and then transmitting the information signal to a communications device. In Bobo II, the end device generates the information signal, but no further transmission is required. Whether or not Witek's teaching of a company logo is applied to Bobo II would not change the result.

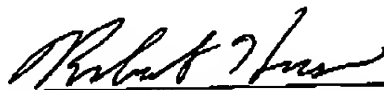
In accordance with the independent claims, the source device generates the information signal which subsequently is transmitted to a communications device. As such, the combination of Bobo II and Witek fails to render obvious the independent claims.

The remaining rejected claims are all dependent claims and as such are novel for at least the same reasons discussed above. Accordingly, applicants respectfully request that these rejections be withdrawn as well and the dependent claims also be allowed to issue.

This response attends to each point noted by the Examiner. The claims are proper and definite. Allowance is accordingly in order and respectfully requested. However, should the Examiner deem that further clarification of the record is in order, we invite a telephone call to Applicant's undersigned attorney, to expedite further processing of the application to allowance.

Respectfully submitted,

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